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| 09/945,261 | 08/31/2001 | Shawn J. Bradley | 020976-2.00US | 1974 |

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| EXAMINER | |
|---|---|
| COBY, FRANTZ | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2171 | 7 |

DATE MAILED: 12/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/945,261 | BRADLEY ET AL. | |
| | Examiner | Art Unit | |
| | Frantz Coby | 2171 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *31* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *31 August 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-48* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-48* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *6*.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

This is in response to application filed on August 31, 2001 in which claims 1-48 are presented for examination.

***Status of Claims***

Claims 1-48 are pending.

***Information Disclosure Statement***

The information disclosure statement filed September 18, 2002 is in compliance with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. It has been placed in the application file and the information referred to therein has been considered as to the merits.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 7, 26-30, 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Stock et al. U.S. Patent no. 6,011,858.

As per claim 1, Stock et al. disclose "a token adapted to provide access to an account, the token comprising a memory configured to store an image of a biometric" by providing a memory card with biometric verification capability that can accommodate

multiple applications, such as financial transaction application (See Stock et al. Col. 2, line 50-Col. 3, line 35).

As per claim 2, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Stock et al. disclose the claimed limitations of "wherein said memory is an integrated circuit configured to store the image of the biometric" by providing a memory card 20 which is a microprocessor-based memory card (See Stock et al. Col. 3, lines 64-67).

As per claim 3, most of the limitations of this claim have been noted in the rejection of claim 2. Applicant's attention is directed to the rejection of claim 2 above. In addition, Stock et al. disclose the claimed limitations of "wherein said biometric image is a finger print image stored in the memory" (See Stock et al. Col. 4, lines 14-27).

As per claim 4, most of the limitations of this claim have been noted in the rejection of claim 3. Applicant's attention is directed to the rejection of claim 4 above. In addition, Stock et al. disclose the claimed limitations of "a magnetic stripe adapted to store data related to the account.

As per claim 7, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above.

In addition, Stock et al. disclose the claimed feature of "a processor configured to read the biometric image stored in the integrated circuit memory disposed in the token" by providing a memory card reader (See Stock et al. Figure 2, component 30 and corresponding text, especially Col. 5, lines 15-29).

As per claim 26, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Stock et al. disclose the claimed feature of "forming a memory" by providing a memory card (See Stock et al. Figure 2, component 20; Col. 3, line 64-Col. 4, line 27); "storing an image of a biometric in the memory; and disposing the memory on the token" (See Stock et al. Col. 4, lines 28-59).

As per claim 27, most of the limitations of this claim have been noted in the rejection of claim 26. Applicant's attention is directed to the rejection of claim 26 above. In addition, Stock et al. disclose the claimed limitations of "wherein said memory is an integrated circuit configured to store the image of the biometric" by providing a memory card 20 which is a microprocessor-based memory card (See Stock et al. Col. 3, lines 64-67).

As per claim 28-29, most of the limitations of these claims have been noted in the rejection of claim 27. Applicant's attention is directed to the rejection of claim 27 above.

In addition, Stock et al. disclose the claimed limitations of "wherein said biometric image is a finger print image stored in the memory" (See Stock et al. Col. 4, lines 14-27).

As per claim 30, most of the limitations of this claim have been noted in the rejection of claim 29. Applicant's attention is directed to the rejection of claim 29 above. In addition, Stock et al. disclose the claimed limitations of "a magnetic stripe adapted to store data related to the account.

As per claim 33, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Stock et al. disclose the claimed features of "receiving the token on which a memory configured to store an image of a biometric is disposed; and reading the biometric image stored in the memory disposed on the token" (See Stock et al. Figure 2, Col. 5, line 16-Col. 6, line 31).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 7-8, 26, 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Stratford et al. U.S. Publication No. 2002/0021001 A1.

As per claim 1, Stratford et al. disclose "a token adapted to provide access to an account, the token comprising a memory configured to store an image of a biometric" by providing a card having a fingerprint microtag contained thereon (See Stratford Figure 1A Pages 2-3, Sections 0027-0035).

As per claim 2, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Stratford et al. disclose the claimed limitations of "wherein said memory is an integrated circuit configured to store the image of the biometric" as a microtag embedded onto a customer's card containing financial information and

As per claim 7, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Stratford et al. disclose the claimed feature of "a processor configured to read the biometric image stored in the integrated circuit memory disposed in the token" by providing a memory card reader (See Stratford et al. Figures 2-3, Component 270; Page 4, Section 0039).

As per claim 8, Stratford et al. disclose the aspect of generating a binary number from the stored image of the biometric by digitizing the biometric information (See Stratford et al. Page 3, Section 0029).

As per claim 26, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Stratford et al. disclose the claimed feature of "forming a memory"; "storing an image of a biometric in the memory; and disposing the memory on the token" (See Stratford et al. Figure 3, component 200; )

As per claim 33, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Stratford et al. disclose the claimed features of "receiving the token on which a memory configured to store an image of a biometric is disposed; and reading the biometric image stored in the memory disposed on the token" (See Stratford et al. Page 4, Section 0040).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 4-6, 8-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stock et al. U.S. Patent no. 6,011,858 in view of Stratford et al. U.S. Publication 2002/0021001 A1.

As per claim 4, most of the limitations of this claim have been noted in the rejection of claim 3. Applicant's attention is directed to the rejection of claim 3 above.

It is noted, however, Stock et al. did not specifically disclose the claimed limitations of "a magnetic stripe adapted to store data related to the account" as recited in the instant claim 4. On the other hand, Startford et al. disclose a biometric authentication card including a magnetic stripe for storing data related to a user's account (See Stratford et al. Figures 1-3 and corresponding text).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the memory card of Stock et al. by incorporating the magnetic stripe teachings of Stratford et al. into the memory card because that would have allowed biometric verification before the card information can be accessed.

As per claims 5-6, most of the limitations of these claims have been noted in the rejection of claim 4. Applicant's attention is directed to the rejection of claim 4 above. In addition, Stratford et al. disclose a card wherein said card is formed from material selected from a group consisting of plastic and metal (See Stratford et al. Page 2, Section 0027).

As per claim 8, most of the limitations of this claim have been noted in the rejection of claim 7. Applicant's attention is directed to the rejection of claim 7 above.

It is noted, however, Stock et al. did not disclose the claimed limitations of "wherein said processor is further configured to generate a binary number from the stored image of the biometric and in accordance with a preselected algorithm" as recited in the instant claim 8. On the other hand, Stratford et al. disclose the aspect of generating a binary number from the stored image of the biometric by digitizing the biometric information (See Stratford et al. Page 3, Section 0029).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the memory card of Stock et al. by applying the digitizing teachings of Stratford et al. because that would have allowed user's biometric information to be stored more efficiently.

As per claim 9, most of the limitations of this claim have been noted in the rejection of claim 8. Applicant's attention is directed to the rejection of claim 8 above. In

addition, Stratford et al. disclose the claimed feature of "a biometric sample adapted to sample and capture an image" (See Stratford et a. Page 4, Section 0038).

As per claim 10, most of the limitations of this claim have been noted in the rejection of claim 9. In addition Stratford et al. disclose the aspect of generating a binary number from the biometric image by digitizing the biometric information (See Stratford et al. Page 3, Section 0029).

As per claim 11, most of the limitations of this claim have been noted in the rejection of claim 10. In addition Stock et al. disclose the aspect of comparing two biometric information to determine a match (See Stock et al. Col. 5, lines 42-54).

As per claim 12, most of the limitations of this claim have been noted in the rejection of claim 11. In addition Stratford et al. disclose the aspect of generating a binary number from the biometric image by digitizing the biometric information (See Stratford et al. Page 3, Section 0029).

As per claims 13-22, most of the limitations of these claims have been noted in the rejection of claim 12. In addition Stock et al. allow transactions at POS where the POS communicates the biometric information with a credit company having a second processor (See Stock et al. Col. 7, lines 29-49). Note that the POS and the credit card

company are located at different sites. Also, Stratford et al. provide a sever for an account agency which includes a database for storing the biometric information.

As per claims 23-25, most of the limitations of these claims have been noted in the rejection of claim 12. In addition Stratford provides a display, (Figure 3, component 310); Stratford et al. disclose the claimed feature of a biometric sample that is a fingerprint (See Stratford et a. Page 4, Section 0038); a magnetic read device (Figure 3, component 250).

As per claim 30, most of the limitations of this claim have been noted in the rejection of claim 29. Applicant's attention is directed to the rejection of claim 29 above.

It is noted, however, Stock et al. did not specifically disclose the claimed limitations of "a magnetic stripe adapted to store data related to the account" as recited in the instant claim 4. On the other hand, Startford et al. disclose a biometric authentication card including a magnetic stripe for storing data related to a user's account (See Stratford et al. Figures 1-3 and corresponding text).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the memory card of Stock et al. by incorporating the magnetic stripe teachings of Stratford et al. into the memory card because that would have allowed biometric verification before the card information can be accessed.

As per claims 31-32, most of the limitations of these claims have been noted in the rejection of claim 30. Applicant's attention is directed to the rejection of claim 30 above. In addition, Stratford et al. disclose a card wherein said card is formed from material selected from a group consisting of plastic and metal (See Stratford et al. Page 2, Section 0027).

As per claim 34, most of the limitations of this claim have been noted in the rejection of claim 33. Applicant's attention is directed to the rejection of claim 33 above.

It is noted, however, Stock et al. did not disclose the claimed limitations of "wherein said processor is further configured to generate a binary number from the stored image of the biometric and in accordance with a preselected algorithm" as recited in the instant claim 8. On the other hand, Stratford et al. disclose the aspect of generating a binary number from the stored image of the biometric by digitizing the biometric information (See Stratford et al. Page 3, Section 0029).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the memory card of Stock et al. by applying the digitizing teachings of Stratford et al. because that would have allowed user's biometric information to be stored more efficiently.

As per claim 35, most of the limitations of this claim have been noted in the rejection of claim 34. Applicant's attention is directed to the rejection of claim 34 above.

In addition, Stratford et al. disclose the claimed feature of "a biometric sample adapted to sample and capture an image" (See Stratford et a. Page 4, Section 0038).

As per claim 36, most of the limitations of this claim have been noted in the rejection of claim 35. In addition Stratford et al. disclose the aspect of generating a binary number from the biometric image by digitizing the biometric information (See Stratford et al. Page 3, Section 0029).

As per claim 37, most of the limitations of this claim have been noted in the rejection of claim 36. In addition Stock et al. disclose the aspect of comparing two biometric information to determine a match (See Stock et al. Col. 5, lines 42-54).

As per claim 38, most of the limitations of this claim have been noted in the rejection of claim 36. In addition Stratford et al. disclose the aspect of generating a binary number from the biometric image by digitizing the biometric information (See Stratford et al. Page 3, Section 0029).

As per claims 39-43, most of the limitations of these claims have been noted in the rejection of claims 38. In addition Stock et al. allow transactions at POS where the POS communicates the biometric information with a credit company having a second processor (See Stock et al. Col. 7, lines 29-49). Note that the POS and the credit card

company are located at different sites. Also, Stratford et al. provides a sever for an account agency that includes a database for storing the biometric information.

As per claims 44-45, most of the limitations of these claims have been noted in the rejection of claim 43. In addition Stratford provides a display, (Figure 3, component 310); Stratford et al. disclose the claimed feature of a biometric sample that is a fingerprint (See Stratford et a. Page 4, Section 0038); a magnetic read device (Figure 3, component 250).

As per claim 46, most of the limitations of this claim have been noted in the rejection of claim 45. Applicant's attention is directed to the rejection of claim 45 above. In addition, Stock et al. disclose the claimed limitations of "wherein said biometric image is stored in the memory" (See Stock et al. Col. 4, lines 14-27).

As per claim 47, most of the limitations of this claim have been noted in the rejection of claim 46. Applicant's attention is directed to the rejection of claim 46 above. In addition, Stock et al. disclose the claimed limitations of "wherein said biometric is a finger print" (See Stock et al. Col. 4, lines 14-27).

As per claim 48, most of the limitations of this claim have been noted in the rejection of claim 47. Applicant's attention is directed to the rejection of claim 47 above. In addition, Stock et al. disclose the claimed limitations of "wherein said memory is an integrated circuit configured to store the image of the biometric" by providing a memory

card 20 which is a microprocessor-based memory card (See Stock et al. Col. 3, lines 64-67).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz Coby whose telephone number is 703 305-4006. The examiner can normally be reached on Monday - Friday from 10:30AM -10:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703 308 1436. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305 3900.

Frantz Coby
Primary Examiner
Art Unit 2171

November 13, 2003